

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH J. SOLON

Appeal No. 2004-0572
Application 09/849,315

ON BRIEF

MAILED

FEB 26 2004

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before GARRIS, PAK, and WARREN, **Administrative Patent Judges.**

GARRIS, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1, 2, 9-11, 13-15 and 24. Of the remaining claims pending in this application, claims 3-8, 12 and 16 are objected to but otherwise allowable, and claims 18-21 are withdrawn from further consideration by the examiner.

The subject matter on appeal relates to a method of storing and handling rubber salvaged from discarded tire carcasses. The method includes the steps of cutting the tire carcasses into flat tire strips excluding sidewalls and stacking the flat strips onto pallets in a plurality of abutting rubber-to-rubber contact configurations. Further details of this appealed subject matter are set forth in representative independent claims 1 and 24, which read as follows¹:

1. The environmentally safe method of storing and handling batches of rubber pieces salvaged from discarded tire carcasses in a bulk storage configuration obtained at low cost for compact storage of residual bulk rubber at bulk storage sites from which bulk rubber may be reclaimed in due course for preparation of rubber products, comprising in combination the steps of: cutting reclaimed tire carcasses into sets of substantially flat storable sections of tire tread strips excluding sidewalls, preparing pallets with loading platform areas of specified length and width dimensions for retaining a plurality of stacks of said substantially flat sections in a storage configuration, and stacking a plurality of the storable sections into said stacks in compact rubber-to-rubber interfacing configurations with frictional resistance against movement of the

¹ We observe that the appellant has inaccurately reproduced the appealed claims in the Appendix of the Brief filed March 27, 2003. For example, the claim 24 reproduction in this Appendix contains numerous errors of omission and in content. No useful purpose would be served by identifying these reproduction errors. Suffice it to say, therefore, that our disposition of this appeal is based upon the actual language of the appealed claims pending in this application.

sections lateral to the pallet platform area thereby to facilitate transportation on said pallets for storing and recalling the pallets from designated storage areas of confined space.

24. The method of bulk storage in outdoor sites of discarded tire rubber without accumulation of water comprising the steps of:

cutting rubber portions of reclaimed tire carcasses in the format into substantially constant thickness flat treaded strips excluding sidewalls, and

stacking the flat strips on pallets in a plurality of abutting rubber-to-rubber contact stacks of the treaded strips interlocked in a frictional format for withstanding lateral movement when travelling upon a loading platform of a pallet transported by a fork lift truck with a rubber-to-rubber contact configuration precluding accumulation of water when stored on the pallets in bulk storage at outdoor locations.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Miller	5,472,750	Dec. 5, 1995
Pignataro	5,834,083	Nov. 10, 1998

Claims 1, 2, 9-11, 13-15 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Pignataro.

On page 7 of the Brief, the appellant indicates that the appealed claims are grouped separately. Therefore, in assessing the merits of the rejection before us, we will

individually consider the claims which have been separately grouped and argued by the appellant. **See Ex parte Shier**, 21 USPQ2d 1016, 1018 (Bd. Pat. App. & Int. 1991) (In order to obtain separate consideration of commonly rejected claims, an appellant must state that the claims do not stand or fall together and must present arguments why the claims are separately patentable). Also see 37 CFR § 1.192(c)(7)(8) (2002).

Rather than reiterate the respective positions advocated by the appellant and by the examiner concerning this rejection, we refer to the Brief (i.e., the Brief filed March 27, 2003) and to the Answer for a complete exposition thereof.

OPINION

For the reasons which follow, we will sustain the above-noted rejection.

In the examiner's view, appealed independent claim 1 distinguishes from Miller by requiring the step of "cutting reclaimed tire carcasses into sets of substantially flat storable sections of tire tread strips excluding sidewalls." Although patentee's method includes a similar step wherein reclaimed tire

carcasses are cut into sets of substantially flat storable sections, these sections include sidewalls as well as tire tread strips (e.g., see the paragraph bridging columns 6 and 7). It is the Examiner's conclusion, however, that it would have been obvious for one having an ordinary level of skill in the art to modify this cutting step so as to remove the sidewalls from the tire carcasses, thereby leaving substantially flat storable sections of only tire tread strips, in view of Pignataro's teaching of such a cutting step.

More specifically, Pignataro discloses a method of removing sidewalls from tire carcasses and stacking the resulting tread strips into a flat configuration on a truck storage bed for transportation to a central recycling facility (e.g., see Figure 4 and lines 51-64 in column 3). These stacked tread strips are ultimately recycled in the form of various construction products (e.g., see the Abstract as well as Figures 5-20 and the Specification disclosure relating thereto in the Pignataro reference). Thus, the issue presented by the rejection before us is whether an artisan with ordinary skill would have found it obvious to modify Miller's cutting step so as

to remove sidewalls and thereby obtain tread strips to be stacked and ultimately used in the manner and for the reasons taught by Pignataro.

In support of his nonobviousness position, the appellant argues that the above-discussed combination proposed by the examiner would render Miller inoperable (e.g., see page 11 of the Brief) apparently because "Miller requires that the sidewalls must be attached to the tire treads to be operational to produce the article of manufacture desired by Miller" (Brief, page 20). It is true that Miller wishes to recycle the whole tire carcass and concomitantly wishes to ultimately manufacture a product made from the recycled whole tire carcass. Nevertheless, this is only one of four primary benefits sought by patentee (e.g., see lines 36-44 in column 1), and the other benefits would be achieved in the modified method proposed by the examiner. More importantly, the Pignataro reference evinces that it was known in the prior art to remove sidewalls for separate recycle (e.g., see the last line of the abstract) in order to obtain only the tire strips for use in manufacturing products made solely therefrom. Under these circumstances, it is clear that the Examiner's

proposed combination would result in a modification of Miller's method so as to obtain and utilize only the tire strips pursuant to the teachings of Pignataro; however, this combination certainly would not render the method of Miller inoperative as the appellant seems to believe.

The appellant further argues that appealed claim 1 includes distinctions over Miller beyond those acknowledged by the examiner and discussed above. In particular, the appellant contends that Miller contains no teaching or suggestion regarding the claim 1 features of storing and handling batches of rubber pieces "in a bulk storage configuration obtained at low cost for compact storage of residual bulk rubber at bulk storage sites from which bulk rubber may be reclaimed in due course for preparation of rubber products" or of "stacking a plurality of the storable sections into said stacks in compact rubber-to-rubber interfacing configurations with frictional resistance against movement of the sections lateral to the pallet platform area." Like the examiner, we find this argument unpersuasive. The first mentioned "bulk storage configuration" feature is disclosed by Miller at lines 53-67 in column 4 and lines 34-63 in

column 7. Moreover, patentee's disclosure of palletizing banded stacks of recycled tire material to facilitate warehousing and handling purposes (e.g., again see lines 46-63 in column 7), when considered in combination with the teachings of Pignataro, would have suggested the second mentioned "stacking" feature wherein tread strip sections are stacked on pallets in rubber-to-rubber configurations.

With regard to appealed claim 9 which depends from claim 1, the appellant argues that the applied prior art contains no teaching or suggestion regarding the here claimed step of piling said flat sections into stacks "that avoid accumulation of water when stored outside in the environment." In support of this argument, the appellant refers to the Declaration under 37 CFR § 1.132, filed December 9, 2002, in which it is asserted that Miller's stacked structure would form cavities, which would accumulate water, as depicted in the sketch on Declaration page 2. The appellant also considers this Declaration to evince that the method of Miller would not yield the previously mentioned rubber-to-rubber feature of independent claim 1.

According to the examiner, this Declaration is deficient in that it is based on opinion rather than objective evidence. The examiner's criticism has merit. For example, the Declaration appears to be evidentiarily inaccurate in that the aforementioned sketch depicts Miller's stacked structure in an "opposing-spoons" configuration rather than the "nested-spoons" configuration disclosed by patentee. Even if the sketch were accurate, the depicted structure seemingly would not accumulate water since the upper stack would function like an umbrella to prevent water from accumulating in the cavity shown in the sketch. Additionally, contrary to the appellant's belief, the Declaration sketch plainly depicts a rubber-to-rubber configuration along the tread strip portions of the stacked structure, and such a configuration is adequate to satisfy the corresponding claim 1 feature.

With further regard to this matter, the appellant's above discussed reliance upon the § 1.132 Declaration is misplaced. That is, the appellant relies upon the Declaration representations concerning the stacked structure resulting from the method of Miller vis-à-vis the method defined by the appealed

claims. While these representations may be relevant to the issue of claim novelty, they are of questionable relevance to the issue of obviousness under consideration. This is because the teachings of Miller and Pignataro, when combined as proposed, would have resulted in a method which would have formed stacks of tire tread strips excluding sidewalls in rubber-to-rubber configurations, which stacks would have avoided water accumulation, in accordance with appealed claims 1 and 9.

With further regard to the claim 9 feature of avoiding water accumulation, the appellant argues that "[t]he elimination of mosquito breeding grounds [i.e., by avoiding water accumulation] in outside bulk storage sites for reclaimable tire rubber is a significant breakthrough in the art and this objective of the invention . . . is not achieved by either cited reference" (Brief, pages 12-13). This argument lacks convincing merit. It is well known in the prior art that "old tire casings . . . often collect stagnant water and serve as breeding grounds for mosquitoes and other pests" (Miller, column 4, lines 38-42). While the elimination of such breeding grounds clearly is desirable, it is not at all clear that such elimination supports

a conclusion of nonobviousness (i.e., for a claim which might be restricted to this desideratum such as appealed dependent claim 9). This is because the record of this appeal contains no support for the appellant's aforequoted assertion that "[t]he elimination of mosquito breeding grounds in outside bulk storage sites for reclaimable tire rubber . . . is not achieved by either cited reference" (Brief, pages 12-13). More particularly, the § 1.132 Declaration is insufficient to establish that the stacked structures of Miller could not avoid water accumulation, and the Declaration does not even contain an assertion that the stacked structures of Pignataro could not avoid water accumulation.

In short, the appellant's argument regarding the elimination of mosquito breeding grounds is not well taken for a number of reasons. First, while this result is concededly desirable, it is clear that not all of the appealed claims are restricted to the achievement of such a result. **See In re Dill**, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA 1979). Second, no support exists for the appellant's assertion that the applied prior art would not be capable of achieving this result. **See In re Merchant**, 575 F.2d 865, 869, 197 USPQ 785, 788 (CCPA 1978).

Third, the record contains no evidence that such a result would have been unexpected to an artisan with ordinary skill. **See In re Freeman**, 474 F.2d 1318, 1324, 177 USPQ 139, 143 (CCPA 1973).

For the reasons set forth above, it is our determination that the reference evidence adduced by the examiner establishes a **prima facie** case of obviousness with respect to appealed claims 1 and 9 which the appellant has failed to successfully rebut with argument and/or evidence of nonobviousness. For analogous reasons, we reach the same determination with respect to appealed independent claim 24. We shall sustain, therefore, the examiner's § 103 rejection of these claims as being unpatentable over Miller in view of Pignataro.

As for the other dependent claims on appeal, it would have been obvious for the artisan to load, stack and handle pallets as required by these claims in view of the previously discussed palletizing disclosure of Miller (i.e., again see lines 46-63 in column 7). We do not perceive and the appellant does not point to any specific feature in any of these claims which is not taught or would not have been suggested by the applied prior art. More specifically, the appellant argues that

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the examiner has reached a conclusion of obviousness regarding dependent claims 2, 11, 14 and 15 "without any evidence or reason" (Brief, page 17). This is incorrect. For example, Miller's aforementioned disclosure of palletizing to facilitate handling with fork lift trucks (see column 7, line 51-53) plainly would have suggested the claim 14 feature of handling loaded pallets with a fork lift truck. Similarly, there is no discernable merit in the appellant's argument that the features of claims 10 and 14 are contrary to the applied references (Brief, page 18). It is clear that Pignataro's disclosure at lines 51-64 of column 3 would have suggested removing sidewalls per claim 10 and stacking without hardware per claim 13.

We also shall sustain, therefore, the examiner's § 103 rejection of claims 2, 10, 11 and 13-15 as being unpatentable over Miller in view of Pignataro.

In summary, we have sustained the examiner's § 103 rejection of all appealed claims.

The decision of the examiner is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 35 CFR § 1.136(a).

AFFIRMED

BRADLEY R. GARRIS

BRADLEY R. GARRIS
Administrative Patent Judge

Chung K. Pak
CHUNG K. PAK

CHUNG K. PAK
Administrative Patent Judge

Robert F. Kennedy

CHARLES F. WARREN
Administrative Patent Judge

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